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10/768,969	01/30/2004	Michael Davis	1105-103.US	4557

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EXAMINER

WEST, LEWIS G

ART UNIT	PAPER NUMBER
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2682

DATE MAILED: 10/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,969

Applicant(s)

DAVIS, MICHAEL

Examiner

Lewis G. West

Art Unit

2682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,8-11,14-16,19-29 and 32-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,8-11,14-16,19-29 and 32-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments filed September 22, 2005 have been fully considered but they are not persuasive.

Regarding at least claim 5, arguments regarding cancelled claims are moot.

Regarding Morris, applicant argues what Morris has and the claimed invention does not. This is not relevant to applicant's claimed invention, as a reference may contain more features than a claimed invention and still read on that invention. Applicant's specified invention may have differences from the specified invention in the prior art, but what is being examined is the claimed invention, and the issue at hand is whether Morris anticipates the claimed invention.

With respect to claim 1, applicant argues that Morris clearly claims an interface (10). Applicant's arguments are that because Morris shows and specifies examples of devices connected to the interface, that it is different from the claimed invention. This argument is unpersuasive, just because a reference shows example of how a device may be connected does not limit it to those connections or limit it only to one specific device at those connections.

This leads to applicant's next argument regarding the added limitation that a plurality of different devices may be used. Morris only specifies that a telephone or a computer may be used and such devices are not limited to any specific model or type in Morris nor is the computer or other interfaceable devices integrated into the interface in any way that would limit the devices to any particular type, therefore this argument is also unpersuasive. See also column 2 of Morris, wherein many configurations of the

Art Unit: 2682

connected devices are contemplated, including the computer being an isolated (discrete) device.

Applicant is also apparently arguing that because internal connections of Morris are referred to as interfaces that the device itself cannot be an interface. This is unpersuasive; just because the term is used in one way in the reference does not mean the term cannot also apply to other parts of the invention, and a synonym of the word interface can read on the limitation interface with equal weight.

The remaining arguments regarding Morris stem from or are variations of the basic argument addressed above and are not persuasive. Applicant is reading limitations into the reference that do not exist.

Regarding Dunn, applicant once again states what Dunn has that the claimed invention does not. Once again, if a reference reads on features of a claim, that claim is anticipated, whether or not the prior art has additional features not contemplated by the applicant. Further, the added limitation uses alternative language, and the reference still applies, as the computer in Dunn is one of a plurality of existing computers and was selected for use with the interface, and further discloses attachment as in claim 32.

Regarding Coulter, again, there are numerous synonymous ways of describing an interface without directly using the specific term; this is a spurious argument.

Further, Coulter is not used to reject, RJ-11, USSB, infrared or serial interfaces.

Strictly with respect to Coulter, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the

Art Unit: 2682

features upon which applicant relies (i.e., RJ-11, USSB, infrared and serial interfaces.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant then argues that “Coulter” is limited to use with one specific brand and model of PIM or PDA. This argument is self-defeating, as applicant has demonstrated at least two possible choices, the PIM or PDA.

Further PIMs and PDAs are computers, and Coulter, as stated above was never used to reject the connections argued by applicant.

Applicant argues the “Coulter completely fails as a reference to support the rejections of claim 2 and 3” An opinionated statement by the applicant with no further support has no weight as evidence.

Drawings

New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because some of the figures are hand drawn and the reference characters throughout the drawings are hand written and of poor quality. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 8-11, 15, 19 and 33-34 are rejected under 35 U.S.C. 102(b) as being anticipated by Morris (US 4,991,197).

Regarding claim 1, Morris discloses a Communications interface device for transferring signals between a selected discrete computer and a selected discrete telephone, the interface device (10) comprising: a housing; interface means (Figure 1, 26) accommodated by the housing for interface signals received from the selected discrete computer and the telephone, the selected discrete computer being one of a plurality of different forms of computer capable of providing signals to the interface means and which can be processed by the interface means, and the selected discrete telephone being one of a plurality of different forms of telephone capable of providing signals to the interface means and which can be processed by the interface means; first connecting means in or on the housing connectable to the selected discrete computer so that signals can be transmitted between the first connecting means and the selected discrete computer (Figure 1 items J1, J6), the first connecting means also being connected to the interface

Art Unit: 2682

means; and a second connecting means in or on the housing connectable to the selected discrete telephone so that signals can be transmitted between the second connecting means and the telephone (Figure 1 J3, J7, J8), the second connecting means also being connected to the interface means. (Figures 1 and 2, column 3 lines 13-57), the selected discrete computer being one of a plurality of discrete computers selectively connectable to the first connecting means and the selected discrete telephone being one of a plurality of discrete telephones selectively connectable to the second connecting means. (Column 3 lines 13-57)

Regarding claim 8, Morris discloses a communications interface device as claimed in claim 1 wherein the telephone is a land telephone, which transmits signals through cables. (Col. 3 lines 13-57; figure 1-item 14)

Regarding claim 9, Morris discloses a communications interface device as claimed in claim 1 wherein the telephone is a wireless telephone. (Column 3 lines 13-57, figure 1 item 20)

Regarding claim 10, Morris discloses a communications interface device as claimed in claim 1 wherein the wireless telephone is one selected from the group consisting of a cellular and PCS telephone. (Column 3 lines 13-57, figure 1 item 20)

Regarding claim 11, Morris discloses a communications interface device as claimed in claim 1 wherein the interface means comprises a modem. (Column 3 lines 13-57, figure 2 item 56).

Regarding claim 15, Morris discloses a communications interface device as claimed in claim 11 further comprising a headset plug for connection to a cellular phone, the headset plug forming the communications interface. (Col. 3 lines 13-57)

Regarding claim 19, Morris discloses a communications interface device as claimed in claim 1 further comprising a power source. (Figure 1 item 22, column 3 lines 24-31)

Regarding claim 33, Morris discloses a communications interface comprising: interface means for interface signals between a selected discrete computer and a telephone; first connecting means connectable to the selected discrete computer and the interface means; and a second connecting means connectable to the telephone and the interface means. (Column 3 lines 13-57, figure 1 item 20), the selected discrete computer being one of a plurality of different forms of computer capable of providing signals to the interface means and which can be processed by the interface means, and the selected discrete telephone being one of a plurality of different forms of telephone capable of providing signals to the interface means and which can be processed by the interface means. (Column 3 lines 13-57)

Regarding claim 34, Morris discloses a method for transferring signals between a Selected discrete computer and telephone, the method comprising: providing interface means for interface signals received from the selected discrete computer and the telephone; connecting first connecting means to the interface means, the first connecting means being connectable to the selected discrete computer so that signals can be transmitted between the first connecting means and the selected discrete computer; and connecting second connecting means to the interface means, the second connecting means being connectable to the telephone so that signals can be transmitted between the second connecting means and the telephone. (Column 3 lines 13-57, figure 1 item 20)

Art Unit: 2682

3. Claims 25 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Dunn. (US 5,995,599)

Regarding claim 25, Dunn discloses a communications interface device comprising: a casing comprising a base portion and a lid hinged thereto, the lid being movable between an open and closed position with respect to the base portion, (Figure 1) the casing defining a chamber (Figure 1); a microphone located within the chamber, a speaker located within the chamber (column 4 lines 30-50); means for varying the distance between the microphone and the speaker (col. 8 line 10-24); a power source; at least one connection to facilitate communication between the interface device and a selected discrete computer (acoustic coupler, column 4 line 51-column 5 line 11), the computer being one of a plurality of different forms of computer capable of providing signals to the interface device and which can be processed by the interface device; and a modem connected to the microphone and/or speaker as well as the connection port. (column 4 line 20-column 5; col. 8 line 10-24)

Regarding claim 32, Dunn discloses a device as claimed in claim 25 further comprising attachment means on the exterior of the casing to facilitate attachment of the interface device. (col. 7 line 17-col. 8 line 23)

4. Claims 1-3 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Coulter (US 6,304,638 B1).

Regarding claim 1, Coulter discloses a Communications interface device for transferring signals between a Selected discrete computer and telephone, the interface device comprising: a housing; interface means accommodated by the housing for

Art Unit: 2682

interface signals received from the Selected discrete computer and the telephone ("acoustic coupler", column 4 line 53-col. 5 line 31); the selected discrete computer being one of a plurality of different forms of computer capable of providing signals to the interface means and which can be processed by the interface means, and the selected discrete telephone being one of a plurality of different forms of telephone capable of providing signals to the interface means and which can be processed by the interface means; first connecting means in or on the housing connectable to the Selected discrete computer so that signals can be transmitted between the first connecting means and the Selected discrete computer, the first connecting means also being connected to the interface means (col. 5 lines 10-31); and a second connecting means in or on the housing connectable to a telephone so that signals can be transmitted between the second connecting means and the telephone, the second connecting means also being connected to the interface means. (Columns 5 lines 10-31), the selected discrete computer being one of a plurality of discrete computers selectively connectable to the first connecting means and the selected discrete telephone being one of a plurality of discrete telephones selectively connectable to the second connecting means. (Col. 5 lines 10-31)

Regarding claim 2, Coulter discloses a communications interface device as claimed in claim 1 wherein the housing comprises a substantially enclosed box, the box having an externally provided recess for receiving a telephone. (Col. 7 line 53-col. 8 line 9)

Regarding claim 3, Coulter discloses a device as claimed in claim 2 wherein the recess is configured so that the telephone is oriented in a substantially vertical position so

Art Unit: 2682

that the antenna thereof is positioned for optimal signal strength. (Col. 7 line 53-col. 8 line 9)

Regarding claim 24, Coulter discloses a communications interface device as claimed in claim 1 further comprising a dial-up Internet access and software for use with a plurality of Selected discrete computers having a plurality of operating systems.

(Column 1 line 54-column 2 line 4)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morris in view of Petersen.

Regarding claim 14, Fukawa discloses a communications interface device as claimed in claim 11, but does not expressly claim insulation on the speaker and microphone. Petersen demonstrates that, by definition, acoustic couplers are known to use insulation. (page 10, entry for "acoustic coupler", page 11, "acoustic modem"). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use insulation on the microphone and speaker to prevent crossover and external noise from interfering with proper signaling.

Art Unit: 2682

6. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al in view of Petersen.

Regarding claim 26, Dunn discloses a communications interface device as claimed in claim 25 further comprising acoustic insulation members on the microphone, but does not expressly disclose insulation on the speaker also. Petersen demonstrates that, by definition, acoustic couplers are known to use insulation. (page 10, entry for "acoustic coupler", page 11, "acoustic modem"). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use insulation on the microphone and speaker to prevent crossover and external noise from interfering with proper signaling.

7. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunn et al in view of Davis.

Regarding claim 27, Dunn discloses a device as claimed in claim 25 with a power source but does not expressly disclose a battery located within the housing. Davis discloses a selected discrete computer telephony interface device with a battery in the housing. (col. 5 lines 52-65) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a battery to make the device more portable.

Regarding claim 28, Dunn discloses a device as claimed in claim 25 wherein the power source is external to the interface device, but does not expressly disclose that the interface device further comprises an AC connector for receiving such power. Davis discloses an AC adaptor to provide external power to a communications device. (col. 5

Art Unit: 2682

lines 52-65) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use an ac adaptor for external power because batteries have limited power supplies.

Regarding claim 29, Dunn does not expressly disclose a communications interface device as claimed in claim 25 wherein the first connecting means comprises an infrared transceiver, but Davis discloses an infrared transceiver for use in selected discrete computer telephony communications. (col. 6 lines 51-65) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use an infrared transceiver as the connecting means as it is a well-known and widely available means for short-range communications.

8. Claims 4, 6, 16, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris in view of Davis.

Regarding claim 4, Morris discloses an interface as in claim 1, but does not expressly disclose RJ-11. Davis discloses a communications interface device as wherein the connecting means is an RJ-11 plug. (col. 4 lines 24-34) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use RJ-11 as the first connections interface, as it is a well-known standard in communications and would be widely available.

Regarding claim 16, Morris discloses an interface as in claim 1, but does not expressly disclose RJ-11. Davis discloses a communications interface device as wherein the connecting means is an RJ-11 plug. (col. 4 lines 24-34) Therefore it would have been

Art Unit: 2682

obvious to one of ordinary skill in the art at the time of the invention to use RJ-11 as the second connection interface as it is a well-known standard in communications and would be widely available.

Regarding claim 20, Morris discloses a power source as in claim 19, but does not disclose a battery expressly. Davis discloses a device wherein the power source is a battery in a selected discrete computer telephony device. (col. 5 lines 52-65) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use a battery to make the device more portable.

Regarding claim 21, Morris discloses a power source as in claim 19, but does not disclose an AC connection expressly. Davis discloses an AC adaptor to provide external power to a communications device. (col. 5 lines 52-65) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use an ac adaptor for external power because batteries have limited power supplies.

Regarding claim 22, Morris does not expressly disclose PCMCIA. Davis discloses a communications interface device as claimed in claim 1 wherein the first connecting means is a compact flash or PCMCIA connection. (Col. 3 line 64-col. 4 line 8) Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to use PCMCIA as the first connection interface as it is a well-known standard in selected discrete computer telephony communications and would be widely available.

Regarding claim 23, Morris does not expressly disclose PCMCIA. Davis discloses a communications interface device as claimed in claim 1 wherein the second connecting means is a compact flash or PCMCIA connection. (Col. 3 line 64-col. 4 line 8) Therefore

Art Unit: 2682


it would have been obvious to one of ordinary skill in the art at the time of the invention to use PCMCIA as the second connection interface as it is a well-known standard in selected discrete computer telephony communications and would be widely available.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lewis G. West whose telephone number is 571-272-7859. The examiner can normally be reached on Monday-Friday 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Quochien B. Vuong can be reached on 571-272-7902. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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